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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/423,974 01/05/00 TERREN

N 05725.0490

EXAMINER

HM12/0917

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FERRMAN, A

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

09/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/423,974	TERREN ET AL.
	<b>Examiner</b> Alycia Berman	<b>Art Unit</b> 1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 March 2000.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 47-106 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 47-106 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

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|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

**DETAILED ACTION**

1. Receipt is acknowledged of the preliminary amendment filed November 17, 1999 and the request for corrected filing receipt filed March 21, 2000. Claims 1-46 have been canceled. Claims 47-106 have been added and are pending. The international search report has been considered.

***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 47-106 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The phrase "conferring a penetration force on the emulsion" in claims 47, 75 and 104 renders the claims indefinite. It is unclear what Applicant intends by this phrase.

6. The term "minimum transfer" in claim 63 is a relative term which renders the claim indefinite. The term "minimum transfer" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. What is the upper limit for "minimum transfer"? Does Applicant intend minimum transfer of the additional ingredient upon application or after application?

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 47-56, 62-67, 69-84, 90-95 and 97-106 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 374 332 A1 (332). US 5,851,539 (539) is used as a translation of EP '332 for reference purposes.

US '539 is directed to water-in-oil type emulsion that comprise a silicone surfactant (title and abstract). The formula (II) of the silicone surfactant at column 8, lines 11-42 encompass the alkyl dimethicone copolyols of the formula instantly claimed. For example, when X is CH<sub>3</sub>, Y is -(CH<sub>2</sub>) -O-(C<sub>2</sub>H<sub>4</sub>O)<sub>n</sub>-(C<sub>3</sub>H<sub>6</sub>O)<sub>n</sub>-R<sub>2</sub> where R<sub>2</sub> is H, R<sub>1</sub> is C<sub>2</sub>-C<sub>6</sub>, a is 21, b is 4 and c is 73, the silicone surfactant corresponds to the alkyl dimethicone copolyol of claim 49. Abil® WE 09, which is the alkyl dimethicone copolyol surfactant preferred by Applicant, is disclosed at column 8, lines 39-40. The silicone

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surfactant comprises between 0.5 and 40 wt.%, preferably between 2 and 10 wt.%, of the emulsion (col. 9, lines 1-4).

For oils and waxes contained in the oily phase, see column 6, line 27 to column 7, line 35. Silicone oils are disclosed at column 7, lines 17-25.

Cyclopentadimethylsiloxane, an instantly claimed volatile cyclic silicone, is disclosed in Example 29 at column 17. Waxes such as ozokerite, polyethylene wax and hydrogenated oils that are solid at 25°C are disclosed at column 6, line 62, column 7, line 3 and at column 7, lines 4-6. The additives, which include oils, waxes and screening agents, vitamins, hormones, antioxidants, preservatives, colorants, perfumes and lipophilic additives conventional in cosmetics (col. 7, lines 45-49) comprise up to 50 wt.% of the oily phase (col. 6, lines 32-34). The aqueous phase comprises 10-90 wt.% of the emulsion and may contain polyols, gelling agents, active ingredients, salts, clay minerals and colorants (col. 7, line 49 to col. 8, line 30). For pigments, pearlescent agents and fillers contained in the oily phase, see column 9, lines 18-39 and 62-63.

The emulsions are prepared by incorporating the aqueous phase into the oily phase using the silicone surfactant (col. 9, lines 40-67). The emulsions may be in the solid state (col. 10, lines 1-21). For various types of cosmetic compositions such as foundation, see column 10, lines 37-45. For application to the skin and/or scalp, see column 10, lines 32-36 and Examples 26-33. See also claims 4, 6, 7 and 11 for water-in-oil emulsions containing silicone surfactants as instantly claimed. See claim 9 for the various components of the oily phase and the aqueous phase. See claim 11 for cosmetic compositions.

US '539 discloses water-in-oil emulsions that can be in the solid form for use as cosmetics such as foundations. They comprise an aqueous phase emulsified in an oily phase by use of a polyoxyalkylated silicone surfactant. They can contain various oils, waxes and pulverulent products in the oily phase. Therefore, US '539 discloses all the limitations of the instant claims listed above.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 47-58, 62-67, 69-86, 90-95 and 97-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 374 332 (332) as translated by US 5,851,539 A (539) and further in view of US 5,196,187 A (187).

US '539 discloses all the limitations of the claims as stated in the 35 U.S.C. 102(b) rejection above. It does not disclose volatile linear silicones having from 2 to 9 silicone atoms as instantly claimed. US '539 does disclose various broad groups of silicone compounds at column 7, lines 17-25 and discloses cyclopentadimethylsiloxane, a volatile cyclic silicone, in Example 29.

US '187 is directed to water-in-oil emulsions containing polyoxyalkylated silicone surfactants (abstract). US '187 discloses that volatile hexamethyldisiloxane can be used interchangeably with volatile cyclic silicones in the water-in-oil emulsions (col. 4, lines 29-37) to provide exceptional cosmetic and sensory properties (col. 1, lines 5-17).

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the emulsion of US '539 using hexamethyldisiloxane as taught by US '187 expecting to obtain a cosmetic emulsion composition with exceptional cosmetic and sensory properties.

12. Claims 47-56, 62-84 and 90-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 374 332 A1 (332) as translated by US 5,851,539 A (539) in further view of US 5,650,139 A (139).

US '539 discloses all the limitations of the claims as stated in the 35 U.S.C. 102(b) rejection above. It does not disclose a wax mixture of polyethylene wax and hydrogenated jojoba oil as instantly claimed.

US '139 is directed to oil-based solid cosmetic compositions comprising a polyoxyalkylated silicone surfactant (abstract). Polyethylene wax and hydrogenated jojoba oil are disclosed at column 3, lines 44-53. US '139 discloses that the oil

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ingredients of the composition may be a mixture (col. 3, lines 44-46). It is within the skill in the art to select optimal components in a composition in order to achieve a beneficial effect. Therefore, it is within the skill in the art to select any optimal combination of oil ingredients as taught by US '139 in order to achieve a desired effect. Absent evidence of unexpected results, the mixture of polyethylene wax and hydrogenated jojoba oil as instantly claimed is not considered patentable over the prior art.

It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the emulsion of US '539 using a mixture of polyethylene wax and hydrogenated jojoba oil as taught by US '139 for their art recognized cosmetic properties.

13. Claims 47-56, 59-67, 69-84, 87-95 and 97-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 374 332 A1 (332) as translated by US 5,851,539 (539) and further in view of US4,536,405 A (405).

US '539 discloses all the limitations of the claims as stated in the 35 U.S.C. 102(b) rejection above. It does not disclose volatile isoparaffins as instantly claimed. US '539 does teach paraffin oil at column 6, line 37. US '405 teaches that conventional water-in-oil cosmetic compositions contain volatile isoparaffins (col. 1, lines 48-50, col. 2, lines 6-10 and col. 2, lines 32-40). US '405 discloses that the water-in-oil emulsions of the reference contain conventional cosmetic ingredients such as volatile isoparaffins (col. 4, lines 13-38).

US '405 discloses volatile isoparaffins in general without any limitations on the specific isoparaffin. It is within the skill in the art to select optimal species from within a

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disclosed genus. Therefore, absent evidence of unexpected results, the particular isoparaffin, i.e. isodecane, isohexadecane and isododecane, is not considered critical.

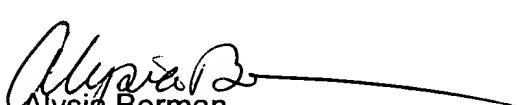
It would have been obvious to one of ordinary skill in the art at the time of the invention to prepare the emulsion of US '539 using any suitable volatile isoparaffin as taught by US '405 for its known cosmetic properties.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alycia Berman whose telephone number is 703-308-4638. The examiner can normally be reached on Monday through Friday from 8:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 or 703-305-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.

  
Alycia Berman  
Patent Examiner  
September 9, 2001

  
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